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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/791,269	03/03/2004	Hyun-Jei Chung	1568.1086	8941
49455	7590	11/26/2007		
STEIN, MCEWEN & BUI, LLP 1400 EYE STREET, NW SUITE 300 WASHINGTON, DC 20005			EXAMINER HODGE, ROBERT W	
			ART UNIT 1795	PAPER NUMBER
			MAIL DATE 11/26/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/791,269

Applicant(s)

CHUNG ET AL.

Examiner

Robert Hodge

Art Unit

1795

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 October 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 2 and 4-18 is/are pending in the application.
- 4a) Of the above claim(s) 5-7 and 9-15 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4, 8 and 16-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

Applicant's arguments filed 10/11/07 have been fully considered but they are not persuasive. Applicants main argument is that neither AAPA nor Kozu teach that the tabs are bent at a substantially right angle with respect to a plane of the sealing surface. This argument was preemptively addressed in the previous office action which will be reiterated herein. "The Examiner notes that in figure 2 the area around where the indicator 18 is located the tabs are bent in an upward direction with respect to a plane of the sealing surface which is also at a substantially right angle and therefore AAPA reads on claims 1 and 3 as so recited", therefore as has already been clarified there is **a bend** (emphasis added) in the tab that is at a substantially right angle with respect to a plane of the sealing surface. It is also quite clear that from the cited figures of Kozu that Kozu is clearly teaching tabs bent only once at a substantial right angle. Therefore it is clear to the Examiner that a skilled artisan armed with the teachings of Kozu would be motivated to modify AAPA as was outlined in the previous office action. Therefore the rejections will be maintained.

Claim Rejections - 35 USC § 102

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1, 2 and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Applicants' Admitted Prior Art (AAPA).

As seen in figures 1 and 2 and described in paragraphs [0003]-[0015] of the instant specification, AAPA teaches a pouch type lithium secondary battery 10 comprising a battery unit 11 comprising a positive electrode plate 13, a negative electrode plate 14, a separator 15 disposed between the positive and negative electrode plates, electrode tabs 16 and 17 extending from the respective positive and negative electrode plates, a case 12 having space 12a to accommodate the battery unit, a sealing surface 12b along the periphery of the space, a protection circuit board 100 electrically connected to the electrode tabs, wherein portions of each of the electrode tabs extend outside the case and are bent in an upright position with respect to a plane of the sealing surface, wherein the electrode tabs are bent at a predetermined length from a leading edge of the sealing surface in a thickness direction of the case, and the electrode tabs further comprise insulating tape 18 between the electrode tabs and the sealing surface such that the insulating tape is wrapped around the portions of the electrode tabs bent from a leading edge of the sealing surface. The Examiner notes that in figure 2 the area around where the indicator 18 is located the tabs are bent in an upward direction with respect to a plane of the sealing surface which is also at a substantially right angle and therefore AAPA reads on claim 1 as recited.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1, 2, 8 and 16-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over AAPA in view of U.S. Pre-Grant Publication No 2005/0112456 hereinafter Kozu.

AAPA as discussed above is incorporated herein.

In the alternative Kozu teaches in figures 4c and 5a, that it is easier to attach a protection circuit board 3, to leads 4 and 5, when the leads are bent at a substantially right angle only once (see also paragraphs [0038] and [0039].

In the alternative it would have been obvious to a person having ordinary skill in the art to bend the tabs of AAPA at a substantially right angle only once such as is conceptually taught by Kozu in order to make it easier to attach the protection circuit board to the tabs and by doing so the tabs of AAPA which are already disposed parallel to an outer wall of the case would be bent in an upright position and would therefore also be perpendicular to the contact surface.

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over AAPA in view of Kozu.

AAPA as modified by Kozu teaches the claimed invention except for locating the protection circuit board disposed between an outer wall of the case and the bent electrode tabs. It would have been obvious to one having ordinary skill in the art at the time the invention was made to relocate the protection circuit board of AAPA as modified by Kozu to a location disposed between an outer wall of the case and the bent electrode tabs, since it has been held that rearranging parts of an invention involves only routine skill in the art. In re Japikse, 86 USPQ 70.

Double Patenting

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 1, 4 and 8 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1 and 3-6 of copending Application No. 11/256,131.

This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 2, 4 and 8 provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-18 of copending Application No. 11/280,463. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the instant application fully encompass the scope of the claims in copending Application No. 11/280,463.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1, 2, 4 and 8 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 2 and 7-20 of copending Application No. 11/265,131. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the instant application fully encompass the scope of the claims in copending Application No. 11/265,131.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Hodge whose telephone number is (571) 272-2097. The examiner can normally be reached on 8:00am - 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick Ryan can be reached on (571) 272-1292. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

RWH


JONATHAN CREPEAU
PRIMARY EXAMINER